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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/848,473 | 05/03/2001 | Troy DeFrees-Parrott | TPG 10400 | 6950 |

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Law Offices of Raymond A. Nuzzo, LLC
P.O. Box 120588
East Haven, CT 06512-0588

| EXAMINER |
|---|
| CAPRON, AARON J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | |

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/848,473 | DEFREES-PARROTT ET AL. | |
| | Examiner | Art Unit | |
| | Aaron J. Capron | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18 and 20-33* is/are pending in the application.

4a) Of the above claim(s) *19,34 and 35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 20-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

MARK SAGER
PRIMARY EXAMINER

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group I (claims 1-18 and 20-33) in Paper No. 5 is acknowledged.

Claims 19 and 34-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4, 9, 11, 13, 17-18, 20-27 and 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Vancura (U.S. Patent No. 6,033,307; hereafter "Vancura").

Referring to claim 1, Vancura discloses a method of operating a gaming system comprising the steps of providing a system at least on casino game of chance and a lottery game device that provides a lottery game (Figure 1 and 5:14-18); providing a player with an opportunity to play the casino game; and providing the player with an opportunity to play the

lottery game upon the occurrence of a predetermined event during play of the casino game (7:35-53).

Referring to claim 2, Vancura discloses a method of operating a gaming system including the step of providing the player with an opportunity to place a wager in order to play the casino game.

Referring to claim 3, Vancura discloses a method of operating a gaming system including the predetermined event is when the player places a wager that meets predetermined criteria (7:41-53: bonus qualifying event is a function of the number of coins played).

Referring to claim 4, Vancura discloses a method of operating a gaming system including a player picks at least three numbers out of total of at least 49 numbers. Vancura discloses that the player can play a Keno type of game which includes the capability of a player picking three numbers out of at least 49 numbers (5:14-18).

Referring to claim 9, Vancura discloses a method of operating a gaming system including a casino game is a slot machine that is configured to accept coins as wagers and wherein the predetermined event is when player inserts a predetermined amount of coins into a slot machine (7:41-53: function of number of coins played).

Referring to claim 11, Vancura discloses a method of operating a gaming system including a slot machine comprising at least one rotating reel having indicia thereon and a payline and wherein the predetermined event is when certain indicia arrives at the payline (Figure 1; 3:13-26 and 7:41-53).

Referring to claim 13, Vancura discloses a method of operating a gaming system including the casino game is a gaming machine having electronic circuitry for generating a

totally impartial, random number, the predetermined event being a number generated by the electronic circuitry (7:41-53: the bonus qualifying event being the occurrence of a random event which is unrelated to the game outcome).

Referring to claims 17 and 18, Vancura discloses a method of operating a gaming system including the step of audibly and visually indicating that the player is entitled to play the lottery game upon the occurrence of the predetermined event (17:46-54).

Claims 20-27 and 30-33 correspond in scope to a gaming system set forth for use of the method listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 5-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Vancura. Vancura discloses at least one of the features listed in each of the claims below, but does not teach all of the features listed in each of the claims below. However, these "untaught" features are equivalent to the features that are disclosed by Vancura.

Referring to claims 5 and 6, Vancura discloses a method of operating a gaming system including the lottery game is Keno.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Huard et al (U.S. Patent No. 5,743,800; hereafter "Huard").

Referring to claim 8, Vancura discloses a method of operating a gaming system including a base poker game and a bonus game (5:14-18) and discloses that the payout can be based on a bonus symbol, but does not specifically disclose that the predetermined event is when a player acquires a predetermined card. However, Huard discloses a card game where a player can trigger a bonus game payout based on a predetermined card (Figure 1 and 2). The two references are analogous since both refer to a card playing game having a bonus feature and triggering the bonus game based on a bonus symbol. One would be motivated to combine the references in order to create excitement for the game since even if a player loses the hand they would still have a chance to win based upon the single card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the single predetermined card of Huard into Vancura's invention in order to enhance player excitement for the game.

Claims 7, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Perrie et al. (U.S. Patent No. 6,173,955).

Referring to claim 14, Vancura suggests that the bonus qualifying event could be based upon a random event (Column 7, lines 41-53), but does not disclose generating a random number and determining if the random number matches a number assigned to a particular amount of

playing time. However, Perrie discloses a method to generate a random number and determines if the random number matches a number assigned to a particular amount of playing time (Column 13, lines 26-37). The references are analogous since both refer to a base game accessing a bonus game based on a triggering event. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Perrie's method of generating the random number to match a number assigned to a particular amount of playing time to Vancura's bonus qualifying event to allow the player to play the bonus game because the bonus qualifying event for the bonus game could be based on a random events.

Referring to claim 12, Vancura in view of Perrie disclose a method of operating a gaming system including the casino game is a gaming machine and the predetermined event is when the player plays the gaming machine a predetermined number of times (Perrie: 14:7-11).

Referring to claim 7, Vancura in view of Perrie disclose a method of operating a gaming system including a base poker game and a bonus game (5:14-18) and that the predetermined bonus event is having a predetermined hand of cards (13:38-49).

Claims 10, 15-16 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Acres et al. (U.S. Patent No. 5,836,817; hereafter "Acres").

Referring to claims 15-16, Vancura discloses a method of operating a gaming system including wide area network, but does not disclose a player tracking system. However, Acres discloses network based gaming machines that incorporate a bonus game that tracks player activity and an accounting data systems in order to verify that the bonus game and withdrawals from the gaming machines are authorized (2:50-3:43). The two references are analogous since

both refer to network based gaming machines having bonus game features. One would be motivate to combine the references in order to give Vancura better security features which would verify that the bonus game and withdrawals from the gaming machines are authorized. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the accounting system and player tracking of Acres into Vancura's invention in order to verify that the bonus game and withdrawals from the gaming machines are authorized.

Referring to claim 10, Vancura in view of Acres disclose a method of operating a gaming system including the slot machine is configured to accept credit as wagers and wherein the predetermined event is when the player plays a predetermined cumulative amount of credit (Acres:23:60-24:3).

Claims 28-29 correspond in scope to a gaming system set forth for use of the method listed in claims listed above and are encompassed by use as set forth in the rejection above.

## *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
December 11, 2002

MARK SAGER
PRIMARY EXAMINER